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10/051,655	01/22/2002	Joseph Raben		8051

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EXAMINER

CAPRON, AARON J

ART UNIT PAPER NUMBER

3714

DATE MAILED: 11/24/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/051,655

Applicant(s)

RABEN, JOSEPH

Examiner

Aaron J. Capron

Art Unit

3714

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 September 2003.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 7 and 8 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 7-8 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

This is a response to the Amendment received on September 15, 2003, in which claims 7-8 were amended and claims 1-6 and 9-15 were cancelled. Claims 7-8 are pending.

Oath/Declaration

The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02.

The oath or declaration is defective because:

--It does not identify the city and either state or foreign country of residence of each inventor. The residence information may be provided on either on an application data sheet or supplemental oath or declaration.

--It does not provide a date that the oath or declaration was signed

Specification

The substitute specification filed September 15, 2003 has not been entered because it does not conform to 37 CFR 1.125(b) and (c) because: a marked-up copy of the specification showing the changes from the original specification to the newly submitted specification is required by the Office.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 7-8 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The Applicant conveys, in the Amendment filed September 15, 2003, that extensive changes were made to the specification that were not supported within the original specification. Thus, the new language was not described in the specification in such a way to reasonably convey to one skilled in the relevant art that the inventor, at the time the application was filed, had possession of the claimed invention.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 7-8 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Referring to claim 7, steps I and J, the claim language fails to particularly point out and distinctly claim that the open squares of step I are either the open squares of the grid or the open squares of the clues. Claim 8 is rejected based upon its dependency upon claim 7.

Claim Objections

Claim 7-8 are objected to because of the following informalities:

Referring to claim 7, steps I and J, the claim language appears to be redundant since the claimed open squares (step I) is not clear and precise on which open squares are meant (either the grid's open squares or the clues' open squares). Appropriate correction is required.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 7-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Anderson in view of Walker in view of Applicant's Admission.

Referring to claim 7, Walker discloses an enhanced interactive puzzle game (2:53-58) which can be played by one or more player (2:59-65) as an interactive competition relating to a game show (2:15-19 and the games of 1:11-13), and a word game that uses clues to facilitate solving the hidden phrase, wherein the clues are used to figure out the correct answer by providing a related topic or general answer having some connection or relevance to the phrase

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(2:53-58), but does not specifically state an acrostic type puzzle game. However, the Applicant admits that prior art includes the use of an acrostic game over the Internet (pages 4-5, paragraph 3) in order to provide an enhanced acrostic game to many remote users. The references are analogous since both Walker and the Applicant's Admission disclose a network game that uses a point based word game that uses clues that are associated with the phrase to solve the phrase and win the game. One would be motivated to combine the references in order to provide an acrostic player with a way to play against other players and be rewarded for their skill. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to include an acrostic game into Walker in order to provide an acrostic player with a way to play against other players and be rewarded for their skill. Further, since Walker discloses his game having Internet access, one could use the game to play the game at jpgames.com.

Walker discloses a display on a computer (Figure 2) that displays a tray of tiles bearing the letter of the alphabets (Figure 2, item 42) and the values of the letters (A=8, B=3, etc.) and a counter to display the current score (Figure 2, item 38) when the letters are entered into squares adjacent to clues or into a grid according to clues provided (Figure 2, item 32).

Walker in view of Applicant's Admission disclose that the correct letters placed into the phrase increase or decrease the player's score (Applicant's Admission, page 4-5, paragraph 3 and Walker 5:7-9) and that letters are entered by the player into selected squares to form words in the clues and the grid (as shown above with respect to Walker and the game of acrostic). The manipulation of score or points is notoriously well known within the art of games and to increase/decrease a player's score by multiples is well within the capability of Walker in view of Applicant's Admission. One would be motivated to increase/decrease a player's score by

multiples in order to generate the player's excitement since more players would play the game for a chance to win more lucrative winnings. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate increasing/decreasing a player's score into the game of Walker in view of Applicant's Admission in order to generate the player's excitement since more players would play the game for a chance to win more lucrative winnings.

Referring to claim 8, Walker discloses that the clues are visual (5:29-36). Walker's clues encompass at least words that are considered as a visual form of a clue.

Response to Arguments

Applicant's arguments filed September 15, 2003 have been fully considered but they are not persuasive.

Applicant argues that Walker in view of Applicant's Admission does not disclose providing visual clues. Applicant's claim language states "a means to link selected clues to visual images associated with the topic of said puzzle." Walker provides visual clues that are viewable by the player (5:29-36). The claim language is not so limiting as to exclude the use of a visual message board that provides a message viewable by the user. Therefore, the claimed invention fails to preclude the obviousness of Walker in view of Applicant's Admission.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Aaron J. Capron whose telephone number is (703) 305-3520. The examiner can normally be reached on M-Th 8-6.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tom Hughes can be reached on (703) 308-1806. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1148.

ajc


JESSICA HARRISON
PRIMARY EXAMINER